

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: William T. Ball  
SERIAL NO.: 10/674,739  
FOR: CAP FOR SEALING A BATHTUB OVERFLOW  
PORT FOR TESTING PURPOSES  
FILED: September 30, 2003  
GROUP/A.U.: 3751  
Confirmation No.: 3981  
EXAMINER: Kathleen J. Prunner

BOX BPAI  
COMMISSIONER OF PATENTS AND TRADEMARKS  
WASHINGTON, D.C. 20231

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 1  
and 2 dated July 23, 2004.

I. Real Party In Interest:

The real party in interest of the instant appeal is  
WCM Industries, Inc. having offices at 2121 Waynoka Road,  
Colorado Springs, CO 80915.

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II. Related Appeals and Interferences:

There are no related appeals or interferences.

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this document and the documents referred to as enclose  
therein are being deposited with the United States Postal Service as First Class  
mail addressed to: BOX BPAI, Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450, on this 16th day of December, 2004.

Timothy J. Zarley

III. Status of the Claims:

Claims 1-2 have been rejected under 35 U.S.C. § 103 as being unpatentable over Oropallo et al. (U.S. Patent No. 6,618,875) in view of Lewis (U.S. Publication No. US 2002/0032926). Claims 1 and 2 are hereby identified as the claims appealed.

IV. Status of Amendments:

Subsequent to the Examiner's final rejection dated July 23, 2004, Applicant filed an Amendment After Final that was entered for the purpose of Appeal.

V. Summary of Invention:

The present invention is an overflow system for a bathtub that has a bottom, adjacent sides and endwalls, a drain port in the bottom, and an overflow port in an endwall. The overflow system comprises a drainpipe that has an inverted L-shape including a horizontal leg extending through the overflow port of the bathtub and a vertical leg extending downwardly for connection with a drain system. The horizontal leg of the drainpipe has a threaded interior that receives a solid cap wherein the solid cap has exterior threads and threadably plugs the overflow port. Additionally, the horizontal leg of the inverted L-shaped drainpipe has exterior threads such that the solid cap can be used during a water testing procedure and then discarded and a conventional overflow cap can be then inserted onto the pipe. Consequently, by adding the interior threads to the overflow port a removable plug can quickly be used and

discarded during water testing while at the same time an aesthetically pleasing cover can be placed on the port.

#### VI. Issues

A first issue is whether combinations of prior art make out a prima facie case of obviousness where there is no teaching or suggestion of the combination. A second issue is, does the combination of the prior art references lead to the invention as claimed to make out a prima facie of obviousness.

#### VII. Grouping of the Claims:

Claims 1 and 2 are both independent claims and stand and fall together and no additional grouping is requested by the Applicant at this time.

#### VIII. Argument:

##### A. Description of the Prior Art

##### 1. Oropallo et al. U.S. Patent No. 6,618,875

The Oropallo device provides a cover cap 10 that covers a tubular terminal 11A of a plumbing line 11 that projects at or through an opening 12 in a bath or shower wall 13. Fig. 13 of the Oropallo disclosure shows a test cap 40 that is threadably connected to the tubular terminal 13A that is able to cover the opening without removal of a retainer ring 21 that receives the decorative cover cap 10. The external threads 22, in combination with the ring 21, thus allows quick removal of a decorative cap 10 and quick installation of a pressure test cap 40 for testing for plumbing leaks. The Oropallo device does not disclose internal threads within

the opening 12 nor a plug element that has external threads so that it may be easily placed within the opening 12 to create a proper seal during the testing procedure.

2. Lewis U.S. Publication 2002/0032926

The Lewis disclosure provides an overflow elbow 12 having externally threaded member 23 extending therefrom that receives the internal threads 22 of a capture nut 21 that fits within a gasket 9 onto the external threads 23 of the elbow 20. Additionally, according to ¶0020 in Lewis, alternatively the threaded member 23 could be formed with interior threads, and the capture nut 21 with outer threads. The capture nut 21 is used to draw elbow 20 toward the tub. Fitting within the opening of the elbow 20, the gasket 9, and the capture nut 21 is a test plug 8 having a threaded screw 5 and a wing nut 7 such that when the wing nut is rotated the plug expands within the opening of the elbow 20. The Lewis disclosure does not provide for a solid test plug with external threads that can be in threaded engagement with the internal threads within an overflow port. Nor does the Lewis device provide for a decorative cap to be placed over the overflow port engaging external threads 23.

B. Argument In Support of Reversal

1. There is no teaching or suggestion to combine the prior art to make out a *prima facie* case of obviousness.

Claims 1 and 2 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo et al. in view of Lewis. There is no suggestion or motivation to combine the prior art to make out a *prima facie* case of obviousness. An obviousness analysis begins in the text of section 103 with

the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion,

teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g. the conventional overflow assembly of Oropallo, combined with the threading on the capture nut of Lewis. To justify this combination the Examiner stated "[i]t would have been obvious to one of ordinary skill in the bathtub overflow system art, at the time the invention was made, to provide the horizontal

leg of the overflow drain pipe of Oropallo et al. with internal threads which engage external threads on the cap in view of the teaching of Lewis in order to create an effective water-tight seal without the need for installation of a decorative overflow plate." (Examiner's Answer, page 3).

While the Examiner has suggested that the nature of the problem is creating an effective water tight seal, the Examiner has not identified within the references a suggestion or motivation to adapt the cap 40 of Oropallo with exterior threads that engage interior threads on tubular member 11a.

The Examiner asserts that the motivation to adapt Oropallo comes from the statement in Lewis at ¶ 0020 where Lewis discloses that "the threaded member 23 could be formed with interior threads, and the capture nut 21 with outer threads". The capture nut 21 in Lewis is used "to compressively draw elbow 20 to tub 10 as shown in Fig. 3b to, in effect, tightly draw foam gasket 9 to the side wall of tub 10 creating, for the first time, a waterproof seal prior to the attachment of the later to be installed trim plate".

[0021] This is similar to Oropallo which teaches the use of ring 21 which is tightened toward wall 13 to frictionally position the ring adjacent the wall as shown at 13b. (Col. 2, lines 59-65). Thus, at best, Lewis suggests that the external threading on 11a and the internal threading 23 on ring 21 on Oropallo may be reversed. Lewis does not suggest that the threads 41 on cap 40 be reversed to engage internal threads on 11a as suggested by the Examiner. See In re Sernaker, 702 F.2d 989, 996; 217 USPQ 1, 19-20 (Fed. Cir. 1983) (reversing the Board's obvious rejection because the

references relied upon did not suggest the combination in the specific manner claimed in the appellant's application).

As outlined in the specification, the Applicant's claimed invention is used for water testing. When the water test is completed the plug (or cap) is removed and discarded (or kept for further use) and the conventional overflow mechanism is inserted on the port. (Pg. 4, lines 15-21). Lewis teaches the use of test plug 8 that is screwed down upon elbow 20 as shown and described with reference to Figs. 3A and 3B to accomplish the testing procedure. Thus, the capture nut 21 does not retain the test plug 8. In this manner, Lewis teaches away from the claimed invention and would have led the applicant down a divergent path.

Accordingly, as the prior art references do not suggest a combination as specifically claimed by the Applicant, and as the prior art teaches away from the claimed testing device, the Examiner's rejection for obviousness must be withdrawn.

## 2. The Combination of the Prior Art References Does Not Lead to the Invention as Claimed.

In addition, the combination of the prior art references does not lead to the invention as claimed. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All

words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 in part requires "a solid cap threaded into interior threads of the horizontal leg extending through the overflow port to close the end of the horizontal leg." Similarly, claim 2 requires "a solid cap threadably mounted in the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded into the first end."

To arrive at the claimed invention, the Examiner has reversed the threads on the capture nut 21 and threaded member 23 of Lewis and combined these elements with Oropallo. This combination, however, results in the ring 21 of Oropallo having external threads that are received by internal threads within tubular member 11a and not cap 40 having external threads received by internal threads within the tubular member 11a as proposed by the Examiner.

The Examiner has argued that "the test of obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. (July 31, 2004 Office Action, pg. 3). As previously set forth, however, at best the prior art suggests an alternative way of frictionally engaging a plumbing line 11 to an overflow port 12 through use of a ring 21 and not an alternative device for testing the water. The only way,

based on the teachings of the prior art, to arrive at the claimed invention, is to use the claim as a frame, taking individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1552 (Fed. Cir. 1983). At no point does the Examiner explain why the mosaic would have been obvious to one skilled in the art, or what would have caused those skilled in the art to disregard the screwed in test plug 8 of Lewis to make such a mosaic.

In contrast, the Examiner has succumbed to hindsight reconstruction by combing through the prior art to find teachings on the various aspects of the claimed invention, and then declaring the claimed invention obvious in light of those references. In In re Fine, the Federal Circuit specifically warned against such "picking and choosing among isolated disclosures in the prior art" and "falling victim to the insidious effect of a hindsight syndrome". 837 F.2d at 1075.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore, 721 F.2d at 1553.

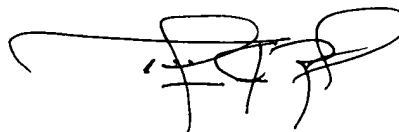
Accordingly, because the proposed combination can only be arrived at by using the claim as a frame, the Examiner's rejection should be withdrawn.

IX. Conclusion

In conclusion, there is no teaching or suggestion to combine Oropallo with Lewis to arrive at the claimed invention. Furthermore, the combination of the prior art does not lead to the invention as claimed and consequently in both respects, the Examiner has failed to present a prima facie case of obviousness. Reversal is therefore respectfully requested.

A check in the amount of \$250 has been included with this appeal brief. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJ Zarley', with a long horizontal flourish extending to the left.

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